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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/770,078	01/25/2001	Katsuhiko Asai	15162/02750	4686
24367	7590	07/07/2005	EXAMINER	
SIDLEY AUSTIN BROWN & WOOD LLP 717 NORTH HARWOOD SUITE 3400 DALLAS, TX 75201				JORGENSEN, LELAND R
ART UNIT		PAPER NUMBER		
				2675

DATE MAILED: 07/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/770,078	ASAI ET AL.	
	Examiner	Art Unit	
	Leland R. Jorgensen	2675	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 03 March 2005.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1, 3 - 31, and 35 - 47 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) 1, 3 - 20, 24 - 31, and 45 - 47 is/are allowed.
 6) Claim(s) 21 - 23 and 35 - 43 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 35 – 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wecker et al., USPN 6,289,464 B1 in view of Freeman et al., USPN 6,068,183.

Claims 35 - 44

Wecker teaches a portable communication terminal [mobile device 10] comprising a display device [display 34] having memory capability [memory 22], a radio communication means [wireless receiver 27] for performing radio communication, and a power source [power supply 35] for supplying power to the communications means and the driver for driving the display device. Wecker, col. 4, lines 61 – 65; col. 5, line 35 – col. 6, line 24; and figures 2 & 4. Although Wecker does not specifically teach a driver for driving the display device to update a display on at least a portion of the display device, such driver would be inherent to the display taught by Wecker. Wecker teaches a controller [processor 20] for inhibiting simultaneous performing of radio communication and updating of at least a portion of the display device so as to limit a load on the power source. Wecker, col. 7, lines 22 – 46; col. 8, lines 44 – 50; and col. 18, lines 43 – 49.

Wecker does not teach the display keeps an image displayed after the driver turns off.

Freeman teaches a display that keeps an image displayed after the driver turns off. Freeman, col. 3, lines 1 – 4; and col. 6, lines 12 – 17.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the powerless display as taught by Freeman with the portable communication terminal to allow the target advertising as taught by Freeman with the power savings taught by Wecker. Freeman teaches the with the powerless display,

The invention also enables businesses to target advertising and other information for transmission to customers by analyzing detailed consumer profiles built from demographic and transaction information. The information sent to the chip card is presented to the consumer whenever the consumer uses the chip card.

Freeman, col. 2, lines 13 – 18. See also Freeman, col. 1, lines 40 – 49; col. 2, lines 8 – 33. Wecker also invites such combination by teaching,

There is a continuing need to improve wireless communication with a mobile device. In particular, there is a need to efficiently process information transmitted over a wireless channel to the mobile device in order to conserve battery resources on the mobile device.

Wecker, col. 2, lines 22 – 26. See also Wecker, col. 1, line 66 – col. 2, line 14.

3. Claims 21 - 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman et al. in view of Valencia et al., USPN 5,380,991, and further in view of Schilling, USPN 5,359,182.

Claims 21 - 23

Freeman teaches a system and method of placing an advertisement on an electronic apparatus [chip card 10] having a display panel [display panel 14a - 14c]. Freeman, col. 3, lines 1 – 5, 32 - 28; and figure 1A and 1C. The system includes setting means for setting the electronic apparatus so that predetermined information is displayed on the display panel if a predetermined service condition has been received. Freeman, col. 1, lines 50 – 64; col. 4, lines 7

Art Unit: 2675

– 10 and 60 – 65. The display panel maintains the display with no power supplied. Freeman, col. 3, lines 1 – 4; and col. 6, lines 12 – 17.

Valencia teaches an electronic apparatus [smart card 2] and method that maintains an identification number of the electronic apparatus and information on the presence or absence of a discount service. It is inherent that such material would be organized into a table. Valencia also teaches a counter for counting a usage charge and subtraction means for reducing the usage charge based on the registered information. Valencia, col. 3, lines 13 – 41; col. 4, lines 4 – 15, 37 – 51; col. 6, lines 40 – 44; col. 7, lines 13 – 17; col. 9, lines 30 – 53. Valencia also teaches a means for charging a user based on the reduced usage charge. Valencia, col. 3, lines 13 – 41; col. 4, lines 4 – 15, 37 – 51; col. 6, lines 40 – 44; col. 7, lines 13 – 17; col. 9, lines 30 – 53.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine detection of the services as taught by Valencia with the electronic apparatus as taught by Freeman. Valencia invites such combination by teaching,

Current food industry practice in the promotion of brand name products generally falls into two categories: new product introduction for creating a demand for a particular product; and existing product promotion for the purpose of retaining or expanding current market share of a particular product. The standard method of promotion used to effectuate these purposes is to provide coupon offerings as price discount inducements to initially try or repurchase a particular product. Currently, the results of these efforts are not cost-effective or easily managed.

Historically, a manufacturer or a retailer would produce a relatively large number of coupons, i.e. in the range of 20 to 50 million, and distribute these coupons to the public. Typically, these coupons would be printed in local or national publications, distributed to customers, mailed directly to potential customers or printed on the packaging of a product which is sold, all to induce the purchasing of this product by the consumer. Furthermore, once the coupon is redeemed by the customer at a retail center, such as a supermarket, the coupons are sent to a clearing house for redemption. If indeed 50 million coupons are

printed, the approximate cost of producing and redeeming these coupons would be approximately \$250,000.

While many customers are inclined to utilize these coupons, due to the increasingly high costs of food and household items, the process of clipping and saving these coupons tends to be time-consuming and cumbersome. Furthermore, once these coupons are retained by the customer, the customer must remember to bring these coupons to the store for redemption. Often times, the customer will not bring his or her coupons when "running into the store" to make a quick purchase. Additionally, once the customer makes his or her purchases, the coupons associated with these purchases must be located among the coupons which the customer is not utilizing, the expiration dates of these coupons must be checked, and the coupons must then be given to the store clerk for scanning or otherwise entering the items into the store's computer. Once the store accumulates a number of coupons, they must then be sent to a redemption center, which in turn informs the various manufacturers of particular coupon usage.

It is not suggested that, due to the tedious nature of this process discount coupons be eliminated, particularly since, due to the high cost of various products, such as breakfast cereals, the manufacturers would expect that customers would utilize discount coupons to make these products more affordable. Rather, it is suggested that a different system should be developed in which discounts can be applied to various products in a more economical and efficacious process.

Valencia, col. 1, lines 11 – 63. Valencia teaches about its invention.

The present invention overcomes the deficiencies of the prior art by employing a paperless coupon redemption system, thereby avoiding the problems of the prior art in which paper coupons must be distributed by a manufacturer, retained by a customer, brought to a consumer outlet, organized at a checkout station, inspected to determine whether the coupons are expired and then redeemed at a central clearing house.

Valencia, col. 2, lines 51 – 58. Valencia invites one to consider different type of cards by adding,

Although FIGS. 1 and 2 describe the construction of a typical IC or smart card, it is noted that the particular construction of this card is unimportant to the teachings of the present invention. What is important is the utilization of a card having an erasable, programmable memory as well as data processing capabilities, so that the information provided in the memory of the card can be compared to information contained in a computer system (and also in every card terminal) for updating the information contained in the card.

Valencia, col. 4, lines 27 – 36. Valencia further states,

Since it is of paramount importance to determine whether a particular customer has previously purchased an item included in the progressive couponing technique, the customer's purchases must be tracked utilizing the smart card. Programmed into the erasable memory of the smart card would be a particular identification number associated with the customer, as well as an indication that a particular item subject to the progressive couponing system has been purchased. The smart card would then be updated by indicating an initial or subsequent purchase of an item subject to the progressive couponing system, as well as by deducting this discounted amount and any amounts discounted utilizing the "shop the dots" system from the customer's receipt total and the total amount presently listed in the card's memory.

Valencia, col. 6, lines 6 – 21. Valencia concludes with the desirability for the information to be tracked on each individual smart card.

It is important to note that, while it is possible that a customer would purchase and completely utilize the discounts available in a single trip to a retail establishment, the system and method according to the present invention contemplates that the customer would retain his or her smart card and utilize it during several trips to one or more retail establishments. Indeed, the fact that the information relating to this customer identification number, and the products previously purchased by the customer, is maintained in the memory of the smart card, allows the customer to employ the smart card at various establishments which are not even linked to one another by a national, or central computer system. The smart card can be recharged with values up to 10,000 times and at any participating store.

Valencia, col. 9, lines 15 – 29.

Neither Freeman nor Valencia specifically teach that the usage is based on a use of the electronic apparatus.

Schilling teaches a wireless debit card that charges for the use of an electronic apparatus. Specifically, Schilling teaches a debit meter 100 coupled with a base station 50.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the debit card that charges for the use of an electronic apparatus as taught by

Schilling with the electronic apparatus as taught by Freeman and Valencia. Schilling invite such combination by teaching,

An object of the invention is a wireless debit card system which allows a user to prepay for telephone usage.

Another object of the invention is a wireless debit card system which allows the user to receive telephone calls at a debit card telephone.

A further object of the invention is a wireless debit card system wherein the telephone number follows the user on his debit card, as opposed to the telephone number being allocated to a specific telephone line.

An additional object of the invention is a wireless debit card system using radio units for accessing telephone networks with smartcards as debit cards, wherein the smartcards are read by the radio unit.

A further object of the invention is a wireless debit card system allowing telephones, facsimile machines, personal computers, automobiles, and the like to communicate using debit cards.

A still further object of the invention is a wireless debit card system allowing users to use telephones, facsimile machines, personal computers, automobiles, and the like with telephone numbers which follow the user on his/her debit card, as opposed to the telephone number being allocated to a specific telephone line.

Schilling, col. 2, lines 33 – 56.

Response to Arguments

4. Applicant's arguments with respect to claims 21 – 23 and 35 - 43 have been considered but are moot in view of the new ground(s) of rejection.

Applicant states that the rejections of claims 21 – 23 under 25 U.S.C. 103(a) as being unpatentable over Freeman in view of Valencia, and further in view of Schilling, is traversed as

being mooted by the cancellation of the subject matter. Claims 21 – 23, however, have not been cancelled and are still pending in this application.

Allowable Subject Matter

5. For the reasons stated in the prior office action, claims 1, 3 – 20, 24 – 31, and 45 – 47 are allowed.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 2675

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leland R. Jorgensen whose telephone number is 571-272-7768. The examiner can normally be reached on Monday through Friday, 10:00 am through 6:00 pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sumati Lefkowitz can be reached on 571-272-3638. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

On July 15, 2005, the Central FAX Number will change to 571-273-8300. This new Central FAX Number is the result of relocating the Central FAX server to the Office's Alexandria, Virginia campus.

Most facsimile-transmitted patent application related correspondence is required to be sent to the Central FAX Number. To give customers time to adjust to the new Central FAX Number, faxes sent to the old number (703-872-9306) will be routed to the new number until September 15, 2005. After September 15, 2005, the old number will no longer be in service and 571-273-8300 will be the only facsimile number recognized for "centralized delivery".

CENTRALIZED DELIVERY POLICY: For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314), and facsimile transmissions must be sent to the Central FAX number, unless an exception applies. For example, if the examiner has rejected claims in a regular U.S. patent application, and the reply to the examiner's Office action is desired to be transmitted by facsimile rather than mailed, the reply must be sent to the Central FAX Number.

Art Unit: 2675

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

lrj

Kent C Chang
KENT CHANG
PRIMARY EXAMINER